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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/009,127	12/20/1993	HISATO SHINOHARA	0756945	2677

22204 7590 07/30/2002

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EXAMINER	
PADGETT, MARIANNE L	
ART UNIT	**PAPER NUMBER**
1762	58

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	56-58

DATE MAILED:

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

#53 #55

1. [X] The communication filed 2/26/02 + 4/23/02 is informal/non-responsive for the reason(s) checked below and should be corrected. APPLICANT IS GIVEN ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION (WHICHEVER IS LONGER) WITHIN WHICH TO CORRECT THE INFORMALITY.

   a. [ ] The amendment to claim(s) _____, filed _____, fails to comply with the provisions of 37 C.F.R. 1.121 and is accordingly held to be non-responsive. A supplemental paper correcting the informal portions and complying with the rule is required.

   b. [ ] The paper is unsigned. A duplicate paper or ratification, properly signed, is required.

   c. [ ] The paper is signed by _____, who is not of record. A ratification or a new power of attorney with a ratification, or a duplicate paper signed by a person of record. is required.

   d. [ ] The communication is presented on paper which will not provide a permanent copy. A permanent copy, or a request that a permanent copy be made by the Office at applicant's expense, is required, see M.P.E.P. 714.07.

   e. [X] Other see attached, particularly p. 4.
   (p. 2-3 respond to remarks of paper #53 or provide clarification)

2. [ ] In accordance with applicant's request, THE PERIOD FOR RESPONSE FROM THE OFFICE ACTION DATED _____ IS EXTENDED TO RUN _____ MONTH(S).
   No further extension will be granted unless approved by the Commissioner. 37 C.F.R. 1.136 (b)

3. [ ] Receipt is acknowledged of papers submitted under 35 U.S.C. 119 which papers have been made of record in the file.

4. [X] Other
2 Interview Summary for
7/17/02 + 7/23/02

NOTICE TO APPLICANT

1. On page 2 of applicant's remarks of 2/26/02 applicants appear to be stating that it is improper for the examiner to maintain the previous rejections of record, however the *Remand* of 2/23/01 from the board made no decisions either reversing or affirming the rejections of record. Whether or not they agree with it, a crucial point that applicants appear to be missing concerning the different interpretations of the claims, is that if the language was so unclear that the actual intended meaning of the claims was not recognized, apparently even by applicants' own representatives before after final, as evidenced by previously discussed prosecution history, then the meaning is clearly ambiguous or vague. No current attempt by applicant to correct this language has been made, nor have they discussed the 112 rejection (section 4, new not "rehashed") of the last action. As noted in the interview of 7/16/02 the resubmitted after final amendment of 11/7/95 would have fixed these problems, as it uses language that clearly expresses the meaning discussed as intended by applicants in their appeal brief. It was not entered at that time as it presented *new issues*, both of meaning and support, hence it was improper to enter at *that time*. That this language is supported by the certified translation of the earliest priority document is clear and has not been at issue. The problem has always been needing to have the proposed language in the claims to necessitate applicants' interpretation *and* reconciling the original language of the 08/169,127 specification with this proposed alternative language (meaning as discussed in the Brief), and showing how it is necessitated and supported by the *original* specification, so that the *claim* language can be shown to be unquestionably supported at the priority date of the earliest priority document.

The original claims, the present claims, and page 6-7 all speak of "expanding the laser beam in a first direction...", which reasonably includes all directions including that of the axis of the beam, and the direction can refer to either the beam **or** the expanding, since applicants have not yet limited these options, or eliminate the ambiguity. Similarly, "condensing said masked laser beam in a second direction orthogonal to said first..." can refer to either the beam **or** the condensing for the claims as written and appealed. Note that interpreting the 1st and 2nd directions to apply to the beam is consistent with the claims *as presently written*, and since orthogonal means perpendicular the beam must be bent at a right angle, as required by simple geometric relationships. (This interpretation would clearly be removed by the proposed amendment of 11/7/95). However, this interpretation is NOT consistent with the certified translation, so as long as the claims remain ambiguously phrased, the priority document does not support *all options encompassed* by the claims, hence can not provide its date to those options not disclosed in the priority document. This is a rephrasing of concepts put forth on pages 3-6 of paper #51, but from applicants' remarks, apparently not understood. These discussions are and were in response to the Boards request for elaboration on the subject of support, which is tied into the subject of meaning.

The examiner is not denying that the alternative interpretation presented by applicants is also a valid one, just that it is the *only one,* which is why the examiner took the time and trouble to discuss both interpretations with respect to both the old and new rejections. From discussions presented after the 11/7/95 after final amendment concerning disclosure on p.6-7, plus figures 1-2

of the original specification, the language of the 11/7/95 rejection would appear to be supported, thus applicants' intended meaning as proposed in their brief, however since it is NOT the only meaning applicable to the claims as written, it appears that the priority date issue cannot be resolved without resolving the ambiguity issue.

Applicants have declared that they do not need to discuss the rejections of sections 4-7 or 9-14 on p. 4 of their 2/26/02 response, hence in neither discussing nor resolving the 112 ambiguity issue (section 4), applicants are non-responsive.

Applicants actually do address the section 5 commonly assigned issue, by citing the priority documents. The examiner notes that the translation of JP 61-229,525 file 9/26/86 supports their statement and eliminates the date gap, and hence this issue. It also means that the art rejection of section 7 would not apply to the claims for meaning as presented in applicants' brief.

The Judicial Double Patenting rejections (sections 8, 11, 12 & 14) are unaffected by the priority date issue, since there is overlapping pendency exists for commonly assigned applications. Applicants' failure to discuss these rejections in anyway, except to say that they will discuss them in the next action is non-responsive.

The new art rejections (sections 9-10) over Hongou (Hongo et al, art supplied by applicant in IDS after the Examiners' Answer), is not discussed, hence the response is further non-responsive.

2. Any inquiry concerning this communication should be directed to M.L.Padgett at telephone number (703) 308-2336 on M-F from about 8 a.m-4:30 p.m, and FAX # (703)872-9310 (regular); 872-9311 (official, after final), or 305-6078 (unofficial).

M.L.Padgett

7/8/02

7/25/02

MARIANNE PADGETT
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GROUP 1700